

## **AMENDMENTS TO THE DRAWING**

The attached sheets of drawing includes changes to Figures 5B and 5C. The sheets, which includes Figures 1A through 15G, replaces the original sheets. In Figures 5B and 5C, previously omitted labels for “Normal” and “Tumor” above the middle column are included.

## **REMARKS**

### Introductory Comments:

Claims 8-12 were examined in the Office Action dated November 06, 2006.

Claim 12 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Claims 8-12 were rejected under 35 U.S.C. §112, second paragraph, as allegedly not being enabled.

Claims 8-12 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting over U.S. Application No. 10/813,417.

Claims 8-12 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting over U.S. Application No. 10/963,855.

The abstract of the disclosure was objected to for exceeding 150 words.

The Examiner objected to Figures 5B and 5C for missing the labels for “Normal” and “Tumor” in the middle column of the graphs.

The specification was objected to for not reflecting the status of parent application, for having incorrect numbers on page 38, and for missing legend to Figures 10A-C.

## **SUPPORT FOR AMENDMENTS**

The applicants have amended the abstract to not exceed 150 words. The amendment finds support in the specification as originally filed, in particular, the abstract as filed.

The applicants have amended the first paragraph of the specification to recite related application information.

The applicants have amended the “Brief Description of the Drawings” to explain the symbols in Figures 10A-10C. Support for the amendment can be found in Figures 10A-10C as originally filed and on page 54, lines 24-27 of the specification.

The applicants have amended the disclosure on page 37, line 33 to page 38, line 25, where the antibody is designated by the number 232 instead of 332, and the agent is designated by the number 234 instead of 334. The amendment corrects for typographical error, and finds support in Figure 3 as filed.

The applicants have amended Figures 5B and 5C to recite “Normal” and “Tumor” above the middle column of graphs for Her1-Her2 dimers. The amendment finds support is the specification and Figures as originally submitted, in particular, the legend in Figures 5B and 5C.

The applicants have amended the preamble of claim 8 to recite that the method is to measuring the amount of Erb-B dimer in patient cancer cells. The claim has further been amended to delete the recitation of “wherein” in line 3, and to delete the steps of comparing to a reference sample, and selecting the patient for treatment. The amendments find support found throughout the disclosure, specifically in the examples, and the amendments corrects for a typographical error.

Claim 9 has been cancelled without prejudice.

Claims 10, 11, and 12 have been amended to correct for dependency.

Claim 11 has been amended to delete the recitation of Erb-B dimer acting drug being 2C4 or Transtuzamab. The amendment thereby makes the body of the claim consistent with the preamble.

Accordingly, no new matter has been added by way of this amendment and the entry thereof is respectfully requested.

### **Addressing the Examiner's Objections**

The Examiner objected to the specification because the first paragraph did not reflecting the status of parent application, for having incorrect numbers on page 38, because Figures 5B and 5C were missing the labels for "Normal" and "Tumor" in the middle column of the graphs, because the legend to Figures 10A-C was missing, because the number identifying the antibody and the agent in the specification did not match the Figures, and because the abstract of the disclosure exceeded 150 words. The amendments above address the Examiner's objection. Therefore, the Examiner is respectfully requested to withdraw the objections.

### **Election of The Species**

In paragraphs 2 and 3, the Office Action requested confirmation of an election of species. Applicants believe that an election of species is not required after the amendments set forth herein. Specifically, Applicants have deleted each of the elected species from the claims.

### **Addressing the Examiner's Rejections**

#### **Rejections of the Claims Under 35 U.S.C. §112**

(a) The Examiner rejected claim 12 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite based on the notion that the concept of an "effective proximity" rendered the term indefinite as the term did not define the metes and bounds of the claimed

subject matter. The term still exists in the amended claims, and Applicants respectfully traverse the basis of the rejection.

According to the specification, an “effective proximity” is the range at which a cleavage-inducing moiety can effectively cleave an inducible linkage (*see* column 16, paragraph 119). A definite claim particularly points out and distinctly claims to one of ordinary skill in the art the subject matter which the Applicants regard as the invention (*see* MPEP 2171 et seq). According to the specification, the term “effective proximity” particularly points out and distinctly claims the subject matter of Applicants invention, and one of ordinary skill in the art would recognize that an effective proximity may depend on the details of a particular assay and may be determined or modified by routine experimentation (Id., last sentence in paragraph 119). Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

(b) The Examiner rejected claims 8-12 under 35 U.S.C. §112, second paragraph, as allegedly not being enabled. The applicants have amended the claims wherein they are now directed to measuring the amount of Erb-B dimer in patient cancer cells. The specification teaches the detection of dimers. Especially in Example 2 and Example 10. Therefore, the Examiner is respectfully requested to withdraw the rejection.

### **Provisional Rejections of the Claims Under Double Patenting**

Claims 8-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims 16-20 and 23 of U.S. Serial No. 10/813,417. The applicants will consider filing a terminal disclaimer upon indication of allowable subject matter.

Claims 8-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims 32 and 33 of U.S. Serial No. 10/963,855. The applicants will consider filing a terminal disclaimer upon indication of allowable subject matter.

## CONCLUSION

Applicants respectfully submit that the claims define an invention that is patentable over the art, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (650) 335-7818.

Respectfully submitted,  
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